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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SALLIARD, SHANNON S

ART UNIT

PAPER NUMBER

3628

MAIL DATE

DELIVERY MODE

06/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/944,534	Applicant(s) DONG ET AL.	
	Examiner SHANNON S. SALIARD	Art Unit 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Applicant has amended claims 1, 2133, and 38. No claims have been newly added or cancelled. Thus, claims 1-39 remain pending and are presented for examination.

Response to Arguments

2. Applicant's arguments filed 21 March 2008 have been fully considered but they are not persuasive.

3. Applicant argues (with respect to claim 1), "There is nothing in Kara that teaches or suggests the claimed feature of having free postage, much less any postage that will expire after a certain period time". However, Examiner disagrees. Kara discloses, "A postage meter must be adjusted, serviced and replenished manually...when the amount of postage programmed within the postage meter has expired, the postage in the meter must be replenished. To be replenishes, a postage meter must be manually unplugged...and an employee must visit a U.S. Post Office to have the meter programmed with additional postage" [col 1, lines 46-55]. Although, Kara does not explicitly state that the postage expires after a period time, this feature is inherent in the disclosure of Kara since the meter had to take some arbitrary period of time before the postage was used up. Further, while it is true that Kara does not teach expiring free postage value, the difference between expiring free postage value and postage value

are only found in the non-functional descriptive material and are not functionally involved in the steps recited. The transferring, storing, and resetting steps would be performed the same regardless of the descriptive material since none of the steps explicitly interact therewith. In other words, the free postage value would only mean something to a person monitoring the output after the final step of the method.

Limitations that are not functionally interrelated with the useful acts, structure, or properties of the claimed invention carry little or no patentable weight. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Ngai*, 70 USPQ2d 1862 (CAFC 2004); *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

4. Applicant argues (with respect to claim 10) that Storace only teaches a total balance is recorded, whereas in the recited system both the purchased postage value and free postage value are stored. Examiner asserts that if Storace stores a total balance of the postage meter in a descending register, then the total balance would include inherently include both the purchased and free postage value.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1, 21, 22, 24, 33, 34 and 36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Storace [US 4,864,506] in view of in view of Kara [US 5,819,240] and an article entitled, "Neopost's Simply Postage, the first PC-based postage system to hit the retail market, is a winner" by Kathy Yakal (hereinafter referred to as 'Yakal').

As per **claim 1**, Storace discloses transferring a first portion of postage value to a postage meter [col 4, line 64-col 5, line 5; col 8, lines 1-8]; and storing a second portion of said postage value in a postage account [col 2, lines 19-25]. Storace does not explicitly disclose resetting a balance of said postage account upon expiration of said postage value after a time period. However, Storace discloses replenishing a postage meter when necessary [col 2, lines 25-36; col 4, lines 35-37]. Furthermore, Kara discloses replenishing a postage meter account upon expiration of postage amount after a time period [col 1, lines 46-51]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Storace to include the method disclosed by Kara so that the user can avoid disruption in service. Storace does not further disclose that the postage is free postage. However, Yakal

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discloses providing free postage to a customer's postage meter on a PC [pg. 1, para. 2-4]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Storace to include the method disclosed by Yakal to encourage use.

As per **claim 2**, Storace further discloses further comprising the step of establishing minimum threshold for said postage meter and transferring a block of postage value from said free postage account to said postage meter when balance of said postage meter is less than or equal to said threshold [col 2, lines 15-31].

As per **claims 3, 22, 24, 34, and 36**, Storace further discloses further comprising the step of decrementing said postage account in accordance with said transferred postage value [col 11, lines 21-23].

As per **claim 9**, Storace does not explicitly disclose further comprising notifying user upon expiration of said free postage value. However, Storace discloses notifying the user that when there is no value left in the postage meter [col 6, lines 19-26].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Storace to include notifying user upon expiration of said free postage value so that the user is aware that there is not a mechanical issue.

As per **claim 10**, Storace further discloses further comprising the step of storing purchased postage value and balance of the postage meter in a descending register [col 4, lines 35-42].

As per **claim 11**, Storace further discloses further comprising the step of decrementing said available postage field in accordance with a print transaction [col 6, lines 31-34].

As per **claims 12 and 13**, Storace further discloses further comprising the steps of determining whether postage meter balance is equal to or greater than a predetermined threshold and transferring a block of free postage value from said free postage account to said postage meter in accordance with said threshold determination [col 2, lines 15-31].

As per **claims 21 and 33**, Storace discloses storing said postage value in a postage account [col 2, lines 20-23]; and transferring a portion of said postage value from a postage account to a postage meter in accordance with a print postage request [col 5, line 34-col 6, line 36]. Storace does not explicitly disclose resetting a balance of said postage account upon expiration of said postage value after a time period.

However, Storace discloses replenishing a postage meter when necessary [col 2, lines 25-36; col 4, lines 35-37]. Furthermore, Kara discloses replenishing a postage meter account upon expiration of postage amount after a time period [col 1, lines 46-51].

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Storace to include the method disclosed by Kara so that the user can avoid disruption in service. Storace does not further disclose that the postage is free postage. However, Yakal discloses providing free postage to a customer's postage meter on a PC [pg. 1, para. 2-4]. Therefore, it would have been

obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Storace to include the method disclosed by Yakal to encourage use.

7. **Claims 4, 5, and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Storace [US 4,864,506] in view of in view of Kara [US 5,819,240] and an article entitled, "Neopost's Simply Postage, the first PC-based postage system to hit the retail market, is a winner" by Kathy Yakal (hereinafter referred to as 'Yakal') as applied to claim 1 above, and further in view of Eddy et al [US 5,812,400].

As per **claim 4**, Storace does not disclose further comprising the step of storing purchased postage value in an available postage account. However, Yakal discloses that the first amount of postage is free and that the user can also purchase postage in a PC account [pg. 1, para 4]. Thus, there is free postage and purchased postage available. Furthermore, Eddy et al discloses a postage meter containing two postage accounts and using the postage in the accounts based on prioritization [col 5, lines 14-22]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Storace to include the step of utilizing said expiring free postage value before said purchased postage value to facilitate distinguishing between account usage.

As per **claims 5 and 25**, Storace does not disclose further comprising the step of utilizing said expiring free postage value before said purchased postage value. However, Yakal discloses that the first amount of postage is free and that the user can also purchase postage in a PC account [pg. 1, para 4]. Thus, there is free postage and

purchased postage available. Furthermore, Eddy et al discloses a postage meter containing two postage accounts and using the postage in the accounts based on prioritization [col 5, lines 14-22]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Storace to include the step of utilizing said expiring free postage value before said purchased postage value so that the user is confident that he/she would like to continue to use the service (i.e., trial period).

8. **Claims 6-8, 23, and 35** are rejected under 35 U.S.C. 103(a) as being unpatentable over Storace [US 4,864,506] in view of in view of Kara [US 5,819,240] and an article entitled, "Neopost's Simply Postage, the first PC-based postage system to hit the retail market, is a winner" by Kathy Yakal (hereinafter referred to as 'Yakal') as applied to claim 1 above, and further in view of Official Notice.

As per **claim 6, 23, and 35**, Storace does not further disclose further comprising the step of displaying a sum of total expiring free postage value and purchased postage value in an available postage field. However, the Examiner takes Official Notice that it is old and well known at the time of the invention in the postal industry to display the sum of available postage value in a postage meter. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Thiel to include the step of displaying a sum of total expiring free postage

value and purchased postage value in an available postage field so that the user knows when the account needs to be replenished.

As per **claim 7**, Storace further discloses further comprising the step of decrementing said available postage field in accordance with a print transaction [col 6, lines 31-34].

As per **claim 8**, Storace does not disclose further comprising the step of utilizing said expiring free postage value before said purchased postage value. However, Yakal discloses that the first amount of postage is free [pg. 1, para 4]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Storace to include the step of utilizing said expiring free postage value before said purchased postage value so that the user is confident that he/she would like to continue to use the service (i.e., trial period).

9. **Claims 14-20, 26-32, and 37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Storace [US 4,864,506] in view of in view of Kara [US 5,819,240] and an article entitled, "Neopost's Simply Postage, the first PC-based postage system to hit the retail market, is a winner" by Kathy Yakal (hereinafter referred to as 'Yakal') as applied to claim 1 above, and further in view of Leon [US 7,085,725].

As per **claims 14, 26 and 37**, Storace does not disclose further comprising the steps of determining validity of said expiring free postage value in response to receipt of a print postage request and wherein said free postage account is reset in accordance with said validity determination. However, Leon discloses determining validity of a

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postage value in response to free postage print request and the account owner is given another amount of free postage value [col 14, line 36-col 16, line 50]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Storace to include the method disclosed by Leon so that the postage provider does not lose revenue.

As per **claims 15 and 27**, Storace does not explicitly disclose further comprising the step of determining whether balance of said free postage value is equal to or greater than a value of requested postage and transferring a block of free postage value from said free postage account to said postage meter in accordance with the amount determination. However, Storace discloses that when a meter reaches a threshold value the postage meter is re-credited from a postage account [col 2, lines 15-31]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Storace to include the step of determining whether balance of said free postage value is equal to or greater than a value of requested postage and transferring a block of free postage value from said free postage account to said postage meter in accordance with the amount determination. to provide a recharging system that is transparent to the postage meter user as suggested by Storace [col 2, lines 61-63].

As per **claims 16 and 28**, Storace further discloses further comprising the step of decrementing said free postage account in accordance with the transferred postage [col 11, lines 21-23].

As per **claims 17 and 29**, Storace further discloses does not further disclose further comprising the step of generating print image in accordance with said amount determination [col 5, lines 38-41].

As per **claims 18-20, and 30-32**, Storace does not explicitly disclose further comprising the step of determining whether balance of total purchased postage value and free postage value is equal to or greater than value of requested postage; generating error message in accordance with said amount determination; and/or generating print image in accordance with said amount determination. However, Storace discloses determining whether requested postage value is equal to a greater than account balance and generating an alert and/or generating a print image [col 6, lines 19-36]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Storace to include determining whether balance of total purchased postage value and free postage value is equal to or greater than value of requested postage; generating error message in accordance with said amount determination; and/or generating print image in accordance with said amount determination so that the postage provider does not lose revenue.

10. **Claim 38** is rejected under 35 U.S.C. 103(a) as being unpatentable over Leon [US 2002/0059145] in view of Fredman [US 6,526,393].

As per **claim 38**, Leon discloses receiving a request to print postage [0011]; and checking for postage value availability [determination of sufficient funds; 0011]. Leon does not further disclose generating an account to track free postage value separate

from purchased postage value; checking for expiration of free postage value; and setting a balance of the account to zero when the free postage value has expired after a time period. However, Fredman discloses generating an account that monitors free postage value and purchased purchase value [plumber sets an account that is paid (i.e., free to user), but the value is returned if the user does not utilize the postage by an expiration date (i.e., postage is purchased by user); col 4, line 29 –col 5, line 14]. Further it is inherent that the postage is checked for expiration since the plumber is refunded postage for items that are not mailed by a certain date. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Leon to include the method disclosed by Fredman to improve response times, lower prices, and improve customer experiences, as suggested by Fredman [col 7, lines 23-30].

11. **Claim 39** is rejected under 35 U.S.C. 103(a) as being unpatentable over Leon [US 2002/0059145] in view of an article entitled, “Neopost’s Simply Postage, the first PC-based postage system to hit the retail market, is a winner” by Kathy Yakal (hereinafter referred to as ‘Yakal’) as applied to claim 38 above, and further in view of Eddy et al [US 5,812,400].

As per **claim 39**, Leon does not further disclose further comprising: applying available free postage value to the request to print postage if free postage value is available; and applying purchased postage to the request to print postage if free postage value is not available. However, Yakal discloses that the first amount of

postage is free and that the user can also purchase postage in a PC account [pg. 1, para 4]. Thus, there is free postage and purchased postage available. Furthermore, Eddy et al discloses a postage meter containing two postage accounts and using the postage in the accounts based on prioritization [col 5, lines 14-22]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Storace to include the step of utilizing said expiring free postage value before said purchased postage value so that the user is confident that he/she would like to continue to use the service (i.e., trial period).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANNON S. SALIARD whose telephone number is (571)272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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